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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1976

No. 76-1425

MAURICE A. GARBELL, INC.,
and
GARBELL RESEARCH FOUNDATION

Petitioners,

v.

THE BOEING COMPANY,

Respondent.

AND

MAURICE A. GARBELL, INC.,
and
GARBELL RESEARCH FOUNDATION

Petitioners,

v.

McDONNELL-DOUGLAS CORPORATION,

Respondent.

PETITION FOR WRIT OF CERTIORARI
to the United States Court of Appeals
for the Ninth Circuit

PETITIONERS' REPLY BRIEF

GEORGE B. WHITE
806 Grant Building
1095 Market Street
San Francisco, Calif. 94103
(415) 621-7065

May 18, 1977

Attorney for Petitioners

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CASE CITATIONS

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Introduction

Respondents' Brief in Opposition outrageously distorts both the facts and the law. It attempts to rationalize the rejection of the statutory presumption of patent validity and the imposition of in-terrorem attorneys' fees against patent holders by a skein of confusion and a tissue of misrepresentation.

I. Respondents Have Misrepresented the Record With Respect to the Pinguino Sailplane.

Respondents' principal thesis for the invalidity of the Garbell wing patent in suit and for a holding of Petitioners' bad faith in prosecuting the lawsuit is that Dr. Garbell did not disclose prior publications of his own work with experimental sailplanes in Italy in 1937-38. The very idea that an inventor is to be held in bad faith because he did not disclose his own prior inventive work is preposterous. Moreover, both in the 1950 suit and in the instant suit the experimental sailplanes were held not to be prior reductions to practice of the invention claimed in the patent in suit. The charge that Dr. Garbell did not disclose his prior work and its publication to the Patent Office is utterly false. Respondents' new claim that a 16-year-old high-school student and assistant of Dr. Garbell's was the co-inventor of Dr. Garbell's invention is without any support in the record and was never even asserted below.

The record shows unequivocally that Dr. Garbell applied for the Garbell wing patent in suit, U.S. Patent No. 2,441,758, on July 16, 1946 (Exh. AU) and was required by the Patent Office Examiner to divide from the parent application certain claims relating to high-camber wing shapes more suitable for relatively low-speed airplane wings (Exh. AU-1). Dr. Garbell complied, and on September 16, 1946, filed a "divisional" application with the divided claims (Exhs. AV and AV-1). That "divisional" patent, U.S. Patent No. 2,498,262, is not in suit here.

Dr. Garbell's prior work and the publication concerning the Italian sailplane flights and other activities predating the patent application were disclosed to the Patent Office Examiner by Dr. Garbell in 1947, during the pendency of the application (R.T. 3459:15 through 3463:10).

The fact that Respondents would base their principal argument to this Court on so obvious a falsehood, in an attempt to confuse this Court into condoning a judgment based upon such a falsehood, demonstrates the need for this Court to intervene.

The other arguments in Respondents' Opposition are mere makeweight. None of them could possibly justify a finding of bad faith in the assertion of the validity of the Garbell wing patent in suit.

Respondents' argument on pages 1 through 19 of Respondents' Brief is an attack on the integrity of Dr. Garbell's conduct before the Patent Office and before District Court Judge Yankwich in the previous "CVAC" action Maurice A. Garbell, Inc., etc. v. Consolidated-Vultee Aircraft Corporation, etc. (94 F.Supp. 843; S.D.Cal. 1950. 204 F.2d 946; 9th Cir. 1953).

First, the Court in these cases Maurice A. Garbell, Inc., etc. v. Boeing Company, etc. 385 F.Supp.1; D.C. Cal. 1973. 546 F.2d 297; 9th Cir. 1976) stated in announcing his decision from the bench on June 2, 1972:

"I do not find fraud here, the kind of fraud that is required for fraud upon the patent office which will invalidate the patent." (R.T. 204:2-4. Emphasis added)

Second, the Court in these cases found:

"E1. Neither the patentee, Dr. Garbell, nor the plaintiffs ever actually reduced to practice the alleged invention covered by Claims 1, 2, 3 and 7 of the patent in suit." (Appendix A-31)

Third, the only evidence on the conduct of Dr. Garbell before the Patent Office is Dr. Garbell's own unrebutted testimony, that at an interview with the Examiner in the Patent Office, as evidenced in the file wrapper (Exh. AU-1), Dr. Garbell disclosed to the Examiner and discussed with the Examiner the published article on his Pinguino and other activities preceding his application which matured into the patent in suit (R.T. 3459:15 through 3463:10). The Examiner held the claims in suit patentable over those disclosures.

Fourth, all of the articles describing the Pinguino and related flight activities in Italy were examined exhaustively at the previous trial before Judge Yankwich in the 1950 trial. Judge Yankwich held the claims in suit patentable over such asserted prior art and publication.

II. Respondents' Reliance on the Curtiss-Wright Evidence Is Untenable.

The Curtiss-Wright evidence was rejected by the Court in the 1950 suit, and Respondents' argument on pages 28 through 34 of their Brief implicitly concedes the correctness of the ruling of the Special Master in these cases:

"It is true that the evidence is less than one would desire to determine definitively and free from doubt what shape the CW-23 airfoil probably took." (Cl.R. 2324:11; Emphasis added).

Respondents now rely mainly on a transmittal memorandum by a patent attorney who was not with Curtiss-Wright at the time of the events pertaining to the CW-21B and -23 models and who, therefore, could not and did not testify in either case to any of those events. That patent attorney merely transmitted to his superior six pages of a 109-page intramural proposal report (Exh. IH-10A) without any explanation as to the contents of the missing 103 pages or the outcome of the

proposal. That patent attorney wrote: "We know of no Curtiss-Wright airplane, except the prior art airplane referred to below which could be construed as coming within the scope of his (Garbell's) patent."

That self-serving hearsay opinion by a patent attorney cannot be used to overcome the statutory presumption of patent validity or to justify the findings that the patent owners were in bad faith.

The attempt to elevate its insignificance on the ground that plaintiffs offered it in evidence, is another distortion of the record. The memorandum was offered by Petitioners as part of an extensive sheaf of correspondence (Exh. 695-1 through 695-71, among others) between the members of the Manufacturers Aircraft Association (subsequently dissolved under a Sherman-Act Judgment in United States of America v. Manufacturers Aircraft Association, S.D.N.Y 72 Civ. 1307, November 11, 1975; CCH 1976-1 Trade Cases, Case 60,810, p. 68,503) for the limited purposes to provide proof of the unobviousness of the patent in suit and of the collaboration between all airframe manufacturers, including the Respondents, in the prior suit (R.T. 2763-2764).

Respondents' claim that the attorney's transmittal memorandum was "corroborated" by numerous engineers is false. The only design engineer who could have corroborated the alleged design of the Curtiss-Wright CW-21B and -23 wings, is Charles Hurkamp. None of the other persons named in Respondents' Brief were design engineers. Mr. Hurkamp, who was the "design engineer" who designed the CW-23 airfoil section for the CW-21B and -23 wing shape, could not remember even seeing the proposal report identified by said six extracted pages (Exh. IH-10A) during his employment at Curtiss-Wright (Hurkamp Deposition Transcript, Special Master Exhibit 300, p. 98, lines 19-20). Mr. Hurkamp did not recollect what was done (Hurkamp Dep.Tr., supra, pp. 28 through 34) and he was not "sure" what kind of airfoil CW-23 was (Hurkamp Dep.Tr., supra, 105:5-10).

III. Further Examples of Respondents' Distortions of the Record.

1. The illustrations opposite page 10 of Respondents' Brief.

Respondents refer to "the prior art Pinguino Wing" as identical with the wing in the Garbell patent in suit. The reference to "the Pinguino Wing" is misleading. The two wing depictions on the page opposite page 10 of Respondents' Brief are identical, because U. S. Patent No. 2,498,262, a divisional application, was divided from the application for U. S. Patent No. 2,441,758 on requirement by the Patent Office Examiner, whereupon the same illustrative drawings were used in both Garbell patents. The same explanation also applies to Figure 3 of both Garbell patents, appearing opposite page 12 of Respondents' Brief.

Patent No. 2,498,262 was not in suit in the CVAC case before Judge Yankwich and is not in suit in the instant cases, and Respondents' argument intermingling it with the patent in suit is employed solely to confuse the issues.

2. There Was No Airplane With an XB-46 Wing Prior to the Filing of the Garbell Patent Application.

Respondents desperately try to make it appear as though there had been an airplane with an XB-46 wing in existence prior to the filing of the application for the patent in suit.

The evidence is that neither a wing nor an airplane of the XB-46 type existed at the time of the execution of the contract for a possible future XB-46 development. Therefore, Respondents' argument on pages 20 through 24 of Respondents' Brief is incorrect.

No "full-scale" aircraft or wing of the XB-46 existed during the employment of Dr. Garbell by Consolidated-Vultee Aircraft Corporation, that is, prior to October 1945; there was only a 3/40th-scale miniature static wind-tunnel model intended and used and usable solely for experimental small-scale static wind-tunnel tests attached to wind-tunnel force-balance scales. (S.M. R.T. 2133:11; R.T. 732:7-13).

Respondents' reference to Exhibit BO in Respondents' Brief, page 21, is also misleading, because that document merely suggested (not "required") a discretionary exchange of information subject to the concurrence and acceptance of the suggestion by each airframe manufacturer. There is no evidence whatsoever of any such acceptance or any such exchange of information in the record of these cases.

Respondents argue but cannot point to any evidence at all that would contradict Dr. Garbell's unrebutted testimony that the XB-46 "mock-up" had a two-section wing and not a Garbell wing and that the Garbell wing was not incorporated in any aircraft until long after October 1945, well within the statutory year. There is nothing in Exhibit BO that could impeach a single word of Dr. Garbell's testimony before Judge Yankwich or in these cases; hence, the insinuations throughout Respondents' Brief are unfounded, unjustifiable, scurrilous, and desperate false accusations.

3. Respondents Distort the Evidence as to a "Tailless Plane"

Respondents' Brief, on pages 22 through 27, is not supported by even a shred of evidence in the record. Their argument is an unfounded distortion of the truth.

The uncontested evidence is that there never was an actual "tailless" CVAC airplane or even an operating wing for a CVAC tailless; hence, there could not have been a tailless airplane "on sale" at the time of Dr. Garbell's visit with Navy Captain Diehl (R.T. 783:24).

The tailless configuration discussed between Dr. Garbell and Captain Diehl (having a two-section wing and not a Garbell wing) is depicted in Exhibit 28 of the CVAC record (pages 685 through 690 of Exh. RM-III in the present record). Therefore, contrary to Respondents' claim, it was examined by Judge Yankwich and is not a "new claim" by Petitioners as Respondents would have this Honorable Court believe.

The argument on pages 25 and 26 of Respondents' Brief about Mr. Abbott's report on the so-called XB-36 wind-tunnel model experiment with an alternate wing is again unfounded and fallacious. That experiment was made by Mr. Abbott after Dr. Garbell's confidential discussion with him (R.T. 1568:9 through 1570:8), and the Confidential Memorandum Report No. L5B23 was declassified and published not in "February", as Respondents claim, but in October of 1945 (Exh. KF), well within the statutory year (Exh. SD, Neill Deposition Tr. p. 15, line 11, through page 16, line 16, and R.T. 1608:13 through 1610:7).

Therefore, Respondents' contention on pages 26 and 27 of the Respondents' Brief, that plaintiffs came into Court with "unclean hands," cannot be based and is not based on any evidence in the record.

4. Trial Delay.

Contrary to Respondents' representations, Plaintiffs made a motion on October 14, 1966, for immediate trial on all issues (Cl. Tr. 633 through 649) which defendants strenuously opposed, and after denial of plaintiffs' motion, defendants continued to exert their enormous economic resources and power to indulge in their eight-year-long discovery proceedings until plaintiffs' funds were at last exhausted and plaintiffs were then compelled, in early 1971, to request continuance of the trial. This circumstance, created by defendants alone, certainly cannot be characterized justifiably as "misconduct on the part of plaintiffs."

Conclusion

The District Court and the Court of Appeals in these actions disregarded the "clear, unequivocal and convincing evidence" requirements adhered to by all of the authorities cited by Petitioners both with respect to evidence needed to overcome the statutory presumption of validity and with respect to the quality of evidence required for holding a case "exceptional."

It is significant that Respondents' Brief in Opposition stoops to gross distortions of the record and a frantic attempt to defame the inventor, Dr. Garbell, rather than to attempt to support the judgment on the record. The reason is that the judgment cannot be supported on the record. The result reached below is a travesty of the statutory presumption of patent validity, and a cruel misapplication of the requirement for imposing attorneys' fees against a patent owner. Moreover, the unfounded and undeserved defamation by Respondents of Dr. Garbell is hardly a fitting reward for the inventor whose invention makes the flights of innumerable DC-8 airplanes and other air-carrier airplanes so much more safe and secure for their passengers and flight crews.

It is respectfully urged that each error of law committed by the District Court and the Court of Appeals be reviewed to the extent required and sufficient to avoid confusion of rules of law applicable to patent cases, and not summarily.

Petitioners pray that their Petition for Writ of Certiorari be granted.

Respectfully submitted,


GEORGE B. WHITE
Attorney for Petitioners

May 18, 1977

PROOF OF SERVICE.

I, George B. White, attorney for Maurice A. Garbell, Inc., and the Garbell Research Foundation, Petitioners herein, and a member of the Bar of the Supreme Court of the United States, hereby certify that, on the 19th day of May, 1977, I served four copies of the foregoing Reply Brief on Petition for a Writ of Certiorari to the Supreme Court of the United States on the Respondents herein, by mailing said four copies in a duly addressed envelope, with first-class postage prepaid, to their attorney of record, namely,

**ROBERT R. THORNTON,
Crocker Bank Plaza, 14th Floor,
611 West Sixth Street,
Los Angeles, Calif. 90017.**

It is certified that all parties required to be served have thus been served.

**GEORGE B. WHITE,
806 Grant Building,
1095 Market Street,
San Francisco, Calif. 94103,
(415) 621-7065.**

Attorney for Petitioners